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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,658	07/16/2003	Arno Schmuck	07244-00141-US	1458
23416	7590	06/16/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/620,658

Applicant(s)

SCHMUCK ET AL.

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11102003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Receipt is acknowledged of IDS filed on 3/11/2004.
2. Claims 1-16 are presented for examination.

#### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

4. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

#### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### ***Arrangement of the Specification***

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) BACKGROUND OF THE INVENTION.
- (d) BRIEF SUMMARY OF THE INVENTION.
- (e) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (f) DETAILED DESCRIPTION OF THE INVENTION.

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The applicant is respectfully requested to amend the specifications so as to incorporate the above titles describing each section of the specifications.

### ***Claim Objections***

5. Claims 2-16 are objected to because of the following informalities:

Re claims 2-8 (page 13; lines 8, 11, 14, 17, 20, 23, and 26): Substitute "A card..." with "The card according..."

Re claims 9-16 (page 14; lines 1, 5, 8, 11, 14, 17, 21, and 25): Substitute "A card..." with "The card according..."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 9-10, and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al. (U.S. 6,623,039).

Re claim 1: Thompson et al. discloses multi-purpose card, which includes a card 16 [as shown in figs. # 3, 7-25 of Thompson et al.] wherein in that an image [herein disclosed as the hologram 50 in fig. # 14. Thompson et al. further teaches that the card 16 can be used having an

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image of a person to verify the user (as shown in fig. # 20; col.9, lines 9+)] is arranged on at least one main surface 22 of the paper core, at least 5% of at least one main surface are covered by a seal and the chip 58 is covered on both main surfaces 22 with a seal or a plastics layer [herein disclosed as a clear laminate 48] (as shown in fig. # 14; col.10, lines 1-65).

Re claim 2: Thompson et al. teaches an apparatus, wherein in that at least one seal consists of plastics [herein Thompson et al. discloses a plastic film 24 or clear coating applied to the main base layer 22] (as shown in fig. # 4; col.5, lines 25+; col.6, lines 44+).

Re claim 3: Thompson et al. discloses an apparatus, wherein in that the paper core 22 comprises a plastics-coated paper (col.5, lines 24+; col.6, lines 60-67; col.7, lines 1+).

Re claim 4: Thompson et al. teaches an apparatus, wherein in the paper core comprises at least one image-receiving layer on at least one main surface 22 (as shown in figs. # 7-9 and 14-15; col. 10, lines 3-32).

Re claim 5: Thompson et al. discloses an apparatus, wherein the image-receiving layer 26 comprises a microporous or gelatine-containing layer [herein disclosed a clear coated 46] (as shown in fig. # 8; col.7, lines 44+).

Re claim 9: Thompson et al. teaches an apparatus, wherein in that it is provided on at least one main surface with a seal which is at least 5% smaller than the main surface (col.5, lines 43+).

Re claim 10: Thompson et al. discloses an apparatus, wherein in that the seal extends at no point to the edge of the card (see fig. # 5 of Thompson et al.).

Re claim 11: Thompson et al. teaches an apparatus, in that the seal covers the recess [perforations 18] for the chip on at least one side (col.).

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Re claim 14: Thompson et al. discloses an apparatus, wherein the card is covered on least one main surface at least over its entire area with a plastic layer (col.5, lines 30+).

Re claim 15: Thompson et al. teaches an apparatus, wherein in that the card is covered on both main surfaces 22 with a plastics layer which projects beyond all the card's edges and the projecting margins of the two layers are welded together (as shown in fig. # 8 of Thompson et al.; col.6, lines 60-67; col.7, lines 1+).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (U.S. 6,623,039) in view of Fraser et al. (U.S. 4,855,583).

The teachings of Thompson et al. have been discussed above.

Thompson et al. fails to teach an image-forming layer comprising a photographic layer.

Fraser et al. discloses structure and method of making combination proximity/insertion identification cards, which includes an image-forming layer 434 comprising a photographic layer (as shown in fig. # 4 of Fraser et al.; col.5, lines 65+; col.7, lines 32+; col.10, lines 15+).

In view of Fraser et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Thompson et al. an image-forming layer comprising a photographic layer so as to authenticate the image of the

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cardholder. Furthermore, such modification would provide adequate security of the card render very visible any falsification/tampering of the image/photograph on the card. Moreover, such modification would have been an obvious extension as taught by Thompson et al., therefore an obvious expedient.

10. Claims 11-13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (U.S. 6,623,039) in view of Prancz (U.S. 6,170,880).

The teachings of Thompson et al. have been discussed above.

Thompson et al. fails to teach a recess with fine structures to accommodate the chip.

Prancz teaches data carrier with a module and a hologram, which includes a stepped recess 5 to accommodate the chip 13 (col.4, lines 1-28).

In view of Prancz's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to form {through various known methods in the art} a recess to accommodate the chip on the card. Furthermore, such modification would permit the manufacture of a thin card by embedding the card through the multi-layer of the card. Moreover, such modification would have been an obvious extension of the teachings of Thompson et al.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carlson (U.S. 5,842,722) discloses printable coplanar laminates and method of making the same.

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Clifford (U.S. 5,985,457) teaches structural panel with Kraft paper core between metal skins.

Jones et al. US 2003/0178495 discloses contact smart having a document core; contact-less smart including multi-layered structure, and method of making the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395.

The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
June 2, 2004



**THIEN M. LE**  
**PRIMARY EXAMINER**